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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,930	09/19/2001	Tsuyoshi Hiramatsu	3273-0146P	3012
2292	7590	05/08/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			CHANG, VICTOR S	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			1771	

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,930

Applicant(s)

HIRAMATSU ET AL.

Examiner

Victor S. Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,8 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,8 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/27/06, 9/26/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' remarks/arguments/IDS filed on 3/27/2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 2, 3, 8 and 22-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 11-254656 (computer translation), generally as set forth in section 5 of Office action dated 10/25/2005, together with the following response to argument.

First, for the purpose of clarity, the Examiner repeats the relied upon prior art as follows: JP 11-254656 is directed to an adhesive sheet for screen printing plate cleaning, which consists of a base (substrate) layer 2 and a self-adhesive foam layer 3 (Drawing). The cleaning sheet is pasted to the screen printing plate to adhere and absorb the ink, so as to remove the ink from the printing plate (Abstract). Suitable adhesives include natural rubber, styrene butadiene rubber, polyisobutylene, styrene-isoprene-styrene block copolymer, acrylic resin (such as a copolymer of acrylic acid and C₂-C₁₀ alkyl ester), styrene-acrylic ester copolymer, etc. (paragraph 0008). Further, JP

'656 expressly teaches that the tackiness of the adhesive layer is 1-200 gf/25-mm (JIS-Z-0237).

Referring to a copy of English translation of JP 11-254656, submitted 3/27/2006, Applicants' argument "... paragraph [0012] of JP '656 ... describes that it is necessary to force a resin composition layer to form foam by using a conventional foaming method when manufacturing the foaming layer of JP '656. On the other hand, the present invention utilizes an adhesive layer wherein this forced foaming forming method is not used. This leads to structural distinctions. The "solid" adhesive layer of the present invention occasionally includes fine foam formed in the step of forming this layer. But this means that the present adhesive layer is structurally different from the foam layer of the JP '656 embodiment. Thus, there is a difference in having "fine foam" present in the claimed "solid" adhesive layer ... versus the foam/foamed layer in the JP '656 ..."

(Remarks, page 3, bottom paragraph and page 4, first paragraph) has been carefully considered, but is not persuasive. The Examiner repeats (see Office action dated 10/25/2005, top paragraph) that the Declaration dated 8/18/2005 by Tsuyoshi Hiramatsu expressly states that the 'solid' adhesive layer "does not mean to exclude layers including fine foam" (Declaration, page 2, middle paragraph), it is the Examiner's position that the self-adhesive layer of JP '656 reads on the instant invention as claimed. Further, despite Applicants' forgoing argument there is a structural difference between JP '656 and instant invention, Applicants fail to clearly point out exactly what is the scope of difference, and it is not seen that how the foaming process results in a structure which is excluded by claim 1 of instant invention. In other words, structurally

JP '656 reads on instant invention as claimed, the fact that JP '656 may also comprise structures not claimed is irrelevant.

With respect to Applicants' argument "... JP '656 utilizes adsorption to the rough surface of the foam layer ... the present invention utilizes absorption, wherein the instantly claimed sheet absorbs the ink on an article ..." (Remarks, page 4, middle paragraph), the Examiner notes: 1) JP '656 expressly teaches that "... absorption of a foam layer removes ink ..." (paragraph 0005); 2) since JP '656 teaches the same adhesive composition, as set forth above, the Examiner asserts that, in the absence of evidence to the contrary, their chemical properties, including solvent absorption, are necessarily the same; 3) as evidenced by the Declaration by Masanobu Yoneda filed 8/18/2005 that Example B made according to JP '656 has solvent absorption of 16 g/m². In other words, the Declaration clearly shows that JP '656 is capable of absorbing ink solvent. Applicants' argument appears semantic and not well taken.

With respect to Applicants' argument "... there exists ... additional patentable distinction of unexpected results ... As shown in the previously filed Rule 132 Declaration (filed August 18, 2005), the efficiency of removal of a solvent-containing substance ... of the present invention (Example A in the Declaration) ... is obviously superior to that of the JP '656 (... Example B in the same Declaration) ..." (Remarks, page 5, bottom paragraph), the Examiner notes that the Declaration by Masanobu Yoneda shows in fact shows Example B has solvent absorption of 16 g/m², which is greater or more efficient than Example A which has solvent absorption of 10 g/m².

Clearly, Applicants' argument appears to be incommensurate with the Declaration, and is not persuasive.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

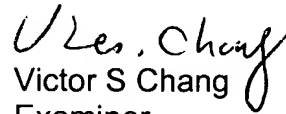
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
Art Unit 1771

5/2/2006